

**REMARKS**

Applicant has studied the Office Action mailed November 5, 2003 and has made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1-23 are pending. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks are respectfully requested. In the Office Action, the Examiner:

- (1-2) rejected claims 1, 3-4, 7-8, 14, 16-17, 20 and 22-23 under 35 U.S.C. § 102(e) as being anticipated by Gongwer (U.S. 6,138,120);
- (3-4) rejected claims 2, 5-6, 15, and 18-19 under 35 U.S.C. § 103(a) as being unpatentable over Gongwer (U.S. 6,138,120) in view of Culliss (U.S. 6,539,377);
- (5) rejected claims 9-11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Gongwer (U.S. 6,138,120) in view of Jaquith et al (U.S. 6,549,941); and
- (6) rejected claims 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Gongwer (U.S. 6,138,120) in view of Jaquith et al (U.S. 6,549,941), and in further view of Culliss (U.S. 6,539,377).

(1-2) Rejection under 35 U.S.C. §102(e) Gongwer

As noted above, the Examiner rejected claims 1, 3-4, 7-8, 14, 16-17, 20 and 22-23 under 35 U.S.C. § 102(e) as being anticipated by Gongwer (U.S. 6,138,120). Independent claims 1, 14, and 22 have been amended to distinguish over Gongwer. Specifically independent claims 1, 14, and 22 have been amended to recite:

receiving, from a second user, a selection for one of the stored queries for sharing in the database.

The Examiner cites 35 U.S.C. § 102(b) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated by Gongwer.<sup>1</sup> The elements in independent claim 1, 14, and 22 of "receiving, from a second user, a

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<sup>1</sup> See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631; 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained

selection for one of the stored queries for sharing in the database" is not taught or disclosed by Gongwer. Accordingly, the present invention distinguishes over Gongwer for at least this reason. The Applicant respectfully submitted that the Examiner's rejection under 35 U.S.C. § 102(b) has been overcome.

As the Examiner correctly states on page 6 of the Office Action, Gongwer does not explicitly disclose:<sup>2</sup>

*capturing search request from shared queried entered by a second user*  
and the Examiner goes on to combine Jaquith.

The Applicant has submitted an affidavit under 37 CFR 1.131 herewith to overcome Jaquith. The effective filing date of Jaquith is November 22, 1999. The present invention was reduced to a writing and signed by the applicant prior to the effective filing date of Jaquith. The present invention was filed not more than one year from the filing date of the above referenced patent. Accordingly, the Applicant respectfully request that the Jaquith reference be removed from consideration and respectfully submitted that the rejection of claims 1, 3-4, 7-8, 14, 16-17, 20 and 22-23 under 35 U.S.C. §102(e) should be withdrawn.

Independent claims 1, 14, and 22 have been amended to distinguish over Gongwer. Claims 2-4, 7-8, 16-17, 20 and 23 depend from claims 1, 14, and 22 respectively. Since dependent claims contain all the limitations of the independent claims, claims 2-4, 7-8, 16-17, 20 and 23 distinguish over Gongwer, as well.

(3-4) Rejection under 35 U.S.C. §103(a) Gongwer and Culliss

As noted above, the Examiner rejected claims 2, 5-6, 15, and 18-19 under 35 U.S.C. § 103(a) as being unpatentable over Gongwer (U.S. 6,138,120) in view of Culliss (U.S. 6,539,377).

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in the ... claim."

<sup>2</sup> This rejection is for claims 9-11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Gongwer (U.S. 6,138,120) in view of Jaquith et al (U.S. 6,549,941), and in further view of Culliss (U.S. 6,539,377) but the same rationale applies here.

Independent claims 1 and 14 have been amended to distinguish over Gongwer taken alone and/or in view of Culliss. Specifically, independent claims 1 and 22 have been amended to recite:

receiving, from a second user, a selection for one of the stored queries for sharing in the database.

The Examiner recites 35 U.S.C. §103. The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole." The Gongwer (U.S. 6,138,120) reference taken alone and/or in view of Culliss (U.S. 6,539,377) simply does not suggest, teach or disclose the patentably distinct limitation of:

receiving, from a second user, a selection for one of the stored queries for sharing in the database.

As the Examiner correctly states on page 6 of the Office Action: Gongwer taken alone and/or in view of Culliss does not explicitly disclose:<sup>3</sup>

*capturing search request from shared queried entered by a second user* and the Examiner goes on to combine Jaquith.

The Applicant has submitted an affidavit under 37 CFR 1.131 herewith to overcome Jaquith. The effective filing date of Jaquith is November 22, 1999. The present invention was reduced to a writing and signed by the Applicant prior to the effective filing date of Jaquith. The present invention was filed not more than one year from the filing date of the above referenced patent. Accordingly, the Applicant respectfully requests that the Jaquith reference be removed from consideration and respectfully submitted that the rejection of claims 2, 5-6, 15, and 18-19 under 35 U.S.C. §103(a) should be withdrawn.

<sup>3</sup> This rejection is for claims 9-11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Gongwer (U.S. 6,138,120) in view of Jaquith et al (U.S. 6,549,941), and in further view of Culliss (U.S. 6,539,377) but the same rationale applies here.

(5) Rejection under 35 U.S.C. §103(a) Gongwer in view of Jaquith

As noted above, the Examiner rejected claims 9-11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Gongwer (U.S. 6,138,120) in view of Jaquith et al (U.S. 6,549,941). The Applicant has submitted an affidavit under 37 CFR 1.131 herewith to overcome Jaquith. The effective filing date of Jaquith is November 22, 1999. The present invention was reduced to a writing and signed by the Applicant prior to the effective filing date of Jaquith. The present invention was filed not more than one year from the filing date of the above referenced patent. Accordingly, the Applicant respectfully requests that the Jaquith reference be removed from consideration and respectfully submitted that the rejection of claims 9-11 and 21 under 35 U.S.C. §103(a) should be withdrawn.

(6) Rejection under 35 U.S.C. §103(a) Gongwer in view of Jaquith and Culliss

As noted above, the Examiner rejected claims 12-13 under 35 U.S.C. § 103(a) as being unpatentable over Gongwer (U.S. 6,138,120) in view of Jaquith et al (U.S. 6,549,941). The Applicant has submitted an affidavit under 37 CFR 1.131 herewith to overcome Jaquith. The effective filing date of Jaquith is November 22, 1999. The present invention was reduced to a writing and signed by the Applicant prior to the effective filing date of Jaquith. The present invention was filed not more than one year from the filing date of the above referenced patent. Accordingly, the Applicant respectfully requests that the Jaquith reference be removed from consideration and respectfully submitted that the rejection of claims 9-11 and 21 under 35 U.S.C. §103(a) should be withdrawn.

**CONCLUSION**

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

In this Response, Applicant has amended certain claims. In light of the Office Action, Applicant believes these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicant respectfully submits that the claim amendments do not limit the range of any permissible equivalents.

Applicant acknowledges the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicant and his attorneys.

Applicant respectfully submits that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested:

**PLEASE CALL** the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

Date: March 1, 2004

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